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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,852	02/20/2004	Kenneth M. Adams	2401,139.US	1650
36139	7590	03/17/2008		
EPSTEIN & GERKEN			EXAMINER	
1901 RESEARCH BOULEVARD			TRUONG, KEVIN THAO	
SUITE 340			ART UNIT	PAPER NUMBER
ROCKVILLE, MD 20850			3734	
		MAIL DATE	DELIVERY MODE	
		03/17/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/781,852	<b>Applicant(s)</b> ADAMS ET AL.
	<b>Examiner</b> Kevin T. Truong	<b>Art Unit</b> 3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 December 2007.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 5-7 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5-7 and 13-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1668)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Note: This is in response to an amendment filed 12/07/2007.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-7 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krause et al. (U.S. 5,152,744) in view of Sjostrom et al. (U.S. 4,705,038).

Krause et al. discloses in figures 1, 2, 7a-7b, and 12, an elongate blade assembly (10) formed of a first elongate outer tubular member (12,112) having a first configuration and a distal end with an opening therein and an inner elongate member (14,114) rotatably disposed in the first outer member (12,112) and having a cutting tip (30) disposed adjacent the opening (24) in the distal end of the first outer member (12,112), the outer and inner members (12,112,14,114) having proximal ends adapted to be received in a handpiece (38) such that the inner member (14,114) is rotated within the outer member (12,112) to cause the cutting tip (30) of the inner member (14,114) to contact and treat tissue at the opening (24) in the distal end of the first outer member (12,112); removing the inner member (14,114) from the first outer member (12,112) (col. 9, lines 16-30); inserting the inner member (120) in a second elongate outer tubular member (12) having a second configuration different from the first configuration and a distal end with an opening therein such that the tissue treating distal end of the inner

member is disposed adjacent the opening in the distal end of the second outer member; and treating tissue of the patient by contact with the cutting tip of the inner member at the opening in the distal end of the second outer member; wherein the first outer member has a first longitudinal configuration and the second outer member a second longitudinal configuration different from the first longitudinal configuration (as shown between figures 7a,7b and 12). Krause et al. does not described the inner member can be removed from the first outer member prior to inserting the inner member in a second outer member during surgical procedure.

However, Sjostrom et al teaches that it is known in the art to have the inner member removed from the first outer member prior to inserting the inner member in other outer member during surgical procedure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inner member of Krasue et al with capability of being removed from the first outer member prior to inserting the inner member into other outer members during surgical procedure as taught by Sjostrom et al. in order to provide a surgical device having different operational limits which enables greater safety, speed and convenience with a single drive unit.

#### ***Response to Arguments***

3. Applicant's arguments filed 12/07/2007 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 5-7 and 13-16 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin T. Truong whose telephone number is 571-272-4705. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM..

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

ktt